



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

17

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,503	09/30/2003	Mark E. Peters	RSW920030081US1 (101)	6041
46320 7590 08/20/2007 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487			EXAMINER FIELDS, BENJAMIN S	
			ART UNIT 3609	PAPER NUMBER
			MAIL DATE 08/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/675,503

Applicant(s)

PETERS ET AL.

Examiner

BENJAMIN S. FIELDS

Art Unit

3609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

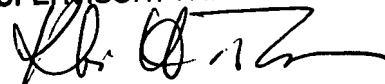
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

KHOI H. TRAN  
SUPERVISORY PATENT EXAMINER



### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-18 of copending Application No. 10/758,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious that the claimed combinations of Claims 1-18 of Application No. 10/758,853 cover the instant claimed application/invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Appropriate action is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US PG Pub. No. 2002/0032616), [hereinafter Suzuki].

Referring to Claim 1: Suzuki discusses a mobile commerce system comprising: a plurality of mobile server wallets each wallet having an association with a corresponding subscriber in a wireless service provider network (Suzuki: Figures 3-4, 6-

Art Unit: 3609

7; Page 2, Paragraph 0030//Suzuki displays figures which depict a system that is capable of facilitating the transactions between multiple mobile server wallet's//); a proxy server disposed in said wireless service provider network (Suzuki: Figures 3-4, 6-7; Page 2, Paragraph 0030//In addition, Suzuki discloses a system which possesses a content proxy server//); and a filter plug-in coupled to said proxy server and configured to intercept selected payment messages flowing through the proxy server and to route said payment messages to selected ones of said mobile server wallets (Suzuki: Page 2, Paragraphs 0028-0029; Page 3, Paragraphs 0033-0038//Upon system authentication within the network, payment messages are routed back and forth via the system through the filter plug-in coupled to the proxy server//).

Referring to Claim 2: Suzuki teaches a mobile commerce system further comprising a plurality of profiles communicatively linked to said filter plug-in, each of said profiles specifying a merchant configured to engage in mobile commerce transactions through said wireless service provider network (Suzuki: Figures 3-4, 6-7; Page 2, Paragraph 0030//Suzuki displays figures which depict a system that is capable of facilitating the transactions between multiple mobile server wallet's, hence, an establishment of profiles which correspond to each mobile server wallet//), said filter plug-in having a further configuration for routing said payment messages said selected ones of said mobile server wallets when a source of said payment messages matches a merchant identity specified in at least one of said profiles (Suzuki: Figures 3, 4, 7; Page 2, Paragraphs 0020-0023//Upon verification of receipt [payment relationship/correlation], a payment transaction process occurs with the system//).

Referring to Claim 3: Suzuki discloses a mobile commerce system wherein individual mobile server wallets are disposed in at least one of an Internet service provider server, said wireless service provider network server, a merchant server, a financial institution server and a portal server.

The examiner notes that the specific group of network communication server's chosen to which the mobile commerce system terminates herein to perform such payment requests does not functionally affect the transaction. These parameters qualify as non-functional descriptive material and do not alter how the method operates. Therefore, this descriptive material is given minimal weight; see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to Claim 4: Suzuki shows a mobile commerce system wherein at least one of said profiles further comprises a specification of a markup language able to be processed in said filter plug-in (Suzuki: Figures 1 & 2; Page 4, Paragraphs 0049-0055//Suzuki shows a terminal equipped with a web browser, a shop server with accessibility to the Hyper Text Transfer Protocol [HTTP], and a wallet server having contents such as Hyper Text Markup Language [HTML]//).

Referring to Claim 5: Suzuki discusses a method for processing mobile commerce transactions in a wireless service provider network, the method comprising the steps of: filtering payment messages flowing between merchants and subscribers to the wireless service provider network to identify specific payment messages associated with specific subscribers in the wireless service provider network (Suzuki: Figure 1(#40);

Art Unit: 3609

Page 2, Paragraphs 0021, 0030; Page 3, Paragraph 0048; Page 4, Paragraph 0053//Suzuki refers to a system which combines multiple mobile server wallet's and allows for financial transactions to take place - The system as disclosed can be utilized by both on-line merchants and end-users//); and routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers (Suzuki: Page 2, Paragraphs 0016, 0023; Page 4, Paragraphs 0052-0053//A unique identifier is traced with the payment transactional information for successful routing//).

Referring to Claim 6: Suzuki teaches a method further comprising the steps of: consulting filters which specify specific ones of said merchants (Suzuki: Figures 3, 4, 7; Page 2, Paragraphs 0020-0023//Suzuki teaches a system which is able to filter processes of both merchants, customers, etc.//); monitoring message traffic flowing from said merchants (Suzuki: Page 2, Paragraphs 0016, 0023; Page 4, Paragraphs 0052-0053//A unique identifier is traced with the payment transactional information for successful routing, hence, a traffic flow is indirectly enabled within the system disclosed//); and intervening in purchase transactions originating in said merchants (Suzuki: Page 2, Paragraphs 0016, 0021, 0030; Page 3, Paragraphs 0031-0032//Suzuki refers to a system which combines multiple MSWP's and allows for financial transactions to take place - Suzuki discloses a e-commerce payment transaction system and method//).

Referring to Claim 7: Suzuki discloses a method wherein said routing step comprises routing filtered ones of said payment message to specified mobile server wallets associated with said specific subscribers and positioned outside of the wireless

service provider network (Suzuki: Page 2, Paragraphs 0016, 0023, 0028-0029; Page 3, Paragraphs 0033-0038; Page 4, Paragraphs 0052-0053//Suzuki provides a system which is able to facilitate payment routing outside and inside the network via a network gateway [GW]//).

Referring to Claim 8: Claim 8 is rejected on the same basis, as is Claim 7, as mentioned supra.

Referring to Claim 9: Suzuki discusses a machine readable storage having stored thereon a computer program for processing mobile commerce transactions in a wireless service provider network (Suzuki: Page 1, Paragraph 0009//Suzuki discloses software and a terminal which can be utilized to facilitate payment transactions, hence, "machine readable storage"//), the computer program comprising a routine set of instructions for causing the machine to perform the steps of: filtering payment messages flowing between merchants and subscribers to the wireless service provider network to identify specific payment messages associated with specific subscribers in the wireless service provider network (Suzuki: Page 2, Paragraph 0016; Page 3, Paragraphs 0031-0032//A payment transaction is dedicated to a given mobile server wallet//); and routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers (Suzuki: Page 2, Paragraphs 0016, 0023; Page 4, Paragraphs 0052-0053//A unique identifier is traced with the payment transactional information//).

Referring to Claim 10: Suzuki teaches a machine readable storage (Suzuki: Page 1, Paragraph 0009//Suzuki discloses software and a terminal which can be utilized to

Art Unit: 3609

facilitate payment transactions, hence, "machine readable storage"//) further comprising the steps of: consulting filters which specify specific ones of said merchants (Suzuki: Figures 3, 4, 7; Page 2, Paragraphs 0020-0023//Suzuki teaches a system which is able to filter processes of both merchants, customers, etc.//); monitoring message traffic flowing from said merchants (Suzuki: Page 2, Paragraphs 0016, 0023; Page 4, Paragraphs 0052-0053//A unique identifier is traced with the payment transactional information for successful routing, hence, a traffic flow is indirectly enabled within the system disclosed//); and intervening in purchase transactions originating in said merchants (Suzuki: Page 2, Paragraphs 0016, 0021, 0030; Page 3, Paragraphs 0031-0032//Suzuki refers to a system which combines multiple MSWP's and allows for financial transactions to take place - Suzuki discloses a e-commerce payment transaction system and method//).

Referring to Claim 11: Suzuki discloses a machine readable storage (Suzuki: Page 1, Paragraph 0009//Suzuki discloses software and a terminal which can be utilized to facilitate payment transactions, hence, "machine readable storage"//) wherein said routing step comprises routing filtered ones of said payment message to specified mobile server wallets associated with said specific subscribers and positioned outside of the wireless service provider network (Suzuki: Page 2, Paragraphs 0016, 0023, 0028-0029; Page 3, Paragraphs 0033-0038; Page 4, Paragraphs 0052-0053//Suzuki provides a system which is able to facilitate payment routing outside and inside the network via a network gateway [GW]//).



Referring to Claim 12: Suzuki shows a machine readable storage (Suzuki: Page 1, Paragraph 0009//Suzuki discloses software and a terminal which can be utilized to facilitate payment transactions, hence, "machine readable storage"//) wherein said routing step comprising routing filtered ones of said payment messages to specified mobile server wallets associated with said specific subscribers and selected by said specific subscribers (Suzuki: Page 2, Paragraphs 0016, 0023; Page 4, Paragraphs 0052-0053//A unique identifier is traced with the payment transactional information//).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Steed et al. (US PG. Pub. No. 2002/0107755) teach a server-based electronic wallet system.

Schuba et al. (US PG. Pub. No. 2002/0052842) show initiation of an electronic payment transaction.

Any inquiry concerning this communication should be directed to Benjamin S. Fields at telephone number 571.272.9734. The examiner can normally be reached Monday through Thursday, 9am to 7pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoi Tran can be reached at (571) 272-

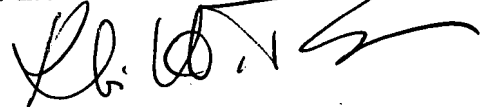
Art Unit: 3609

6919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin S. Fields  
9 August 2007

KHOI H. TRAN  
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Khoi H. Tran', is written over the printed name and title.